



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,005	03/29/2001	Michael D. Ellis	UV/189	8533

1473 7590 07/26/2006

FISH & NEAVE IP GROUP
ROPES & GRAY LLP
1251 AVENUE OF THE AMERICAS FL C3
NEW YORK, NY 10020-1105

EXAMINER

SHEPARD, JUSTIN E

ART UNIT	PAPER NUMBER
----------	--------------

2623

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,005

Applicant(s)

ELLIS ET AL.

Examiner

Justin E. Shepard

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-7,10-17,24-30,33-35,38-45 and 52-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7,10-17,24-30,33-35,38-45 and 52-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/8/06 has been entered.

Response to Arguments

Applicant's arguments filed 2/8/06 have been fully considered but they are not persuasive.

Page 11, paragraph 4 (referring to claim 1):

The applicant argues that the new limitation of the user equipment predicting a time change associated with a program is not found in Inoue. Column 8, lines 57-58 of Inoue states that the system judges whether the updated program overlaps with the recording time of the other plural reserved programs. This judging is interpreted as being equivalent to predicting a time change associated with a program. I.e., if a baseball game goes longer than its scheduled slot, then a program that is scheduled to be recorded afterwards will be judged and the recording time will be adjusted accordingly. The rejection has been updated to included the new limitation, but the cited art has not changed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-2, 5-7, 10-17, 24-26, 29-30, 33-35, 38-45, 52-54, and 57-58** are rejected under 35 U.S.C. 102(e) as being anticipated by Inoue et al. (US 6,185,360).

Regarding claim **1**, Inoue teaches a method for use in a recording system for reducing cut-offs when programs are recorded, the method comprising: receiving at the user equipment a user selection of a program to record (See Fig. 11 B Step 4); predicting by the user equipment a time change associated with the program, wherein the predicted time change is based on time changes for previous programs related to the program (See Fig. 11C Step 8 and Col. 8 lines 32-67); and recording by the user equipment the program to compensate for a time change based on the predicted time change (See Fig. 11C and Step 11 and Col. 8 lines 32-67).

Regarding claim **2**, Inoue teaches wherein the predicted time change comprises predicted time delay information (See Col. 1 lines 8-15).

Regarding claim **5**, Inoue teaches wherein the predicted time delay information is based on previously logged time changes (See Fig. 11C Step 8, 11 and Col. 1 lines 14-30 Col. 8 lines 32-59. Service information about a program change stored in memory before the broadcast of the program is a previously logged time change).

Regarding claim **6**, Inoue teaches further comprising displaying a predicted time delay information for the program (See Fig. 11C Step 11 and Col. 8 lines 46-59. Changing EPG is displaying time delay information).

Regarding claim **7**, Inoue teaches wherein the predicted time change comprises predicted time extension information (See Fig. 6A-B and Col. 8 lines 32-46).

Regarding claim **10**, Inoue teaches wherein the predicted time extension information is based on previously logged time changes (See Fig. 6A-B and Col. 8 lines 32-46 Time extension information stored in memory up until the completion of the baseball game is a previously logged time change).

Regarding claim **11**, Inoue teaches further comprising displaying a predicted time extension information for the program (See Fig. 6A-B, Fig. 11C Step 11, and Col. 8 lines 32-46).

Regarding claim **12**, Inoue further teaches providing a user with an opportunity to select a recording start time (See Col. 3 lines 28-33 Recording a program directly is selecting a recording start time).

Regarding claim **13**, Inoue further teaches automatically selecting the recording start time (See Col. 3 lines 28-33 automatically recording a desired program includes automatically selecting the recording start time).

Regarding claim **14**, Inoue further teaches providing a user with an opportunity to select to have automatic selection of the recording start time (See Col. 3 lines 28-32).

Regarding claim **15**, Inoue further teaches providing a user with an opportunity to select a recording end time (See Col. 3 lines 28-33 Recording a program directly is selecting a recording end time).

Regarding claim **16**, Inoue further teaches automatically selecting the recording end time (See Col. 3 lines 28-33 automatically recording a desired program includes automatically selecting the recording end time).

Regarding claim **17**, Inoue further teaches providing a user with an opportunity to select to have automatic selection of the recording end time (See Col. 3 lines 28-33).

Regarding claim **24**, Inoue further teaches displaying an icon in a program listing for the program to indicate that the predicted time change is available (See Fig. 6B Extending Baseball rectangle).

Regarding claim **25**, Inoue further teaches displaying an icon in a program listing for that program that indicates the program is to be recorded (See Col. 7 lines 60-65).

Regarding claim **26**, Inoue further teaches trimming a recording time of the scheduled program or an adjacent program to reduce the cut-off in a program recording (See Fig. 6A-B, Col. 8 lines 20-25, 32-67, and Col. 9 lines 1-35 If overlap is detected a decision is made as to which program is to be recorded. Fig. 6A shows the original recording schedule with the shaded regions showing the programs to be recorded. Fig. 6B shows the modified recording schedule where the recording of Jurassic Land is trimmed to reduce the cut-off in the program recording of Baseball).

Regarding claim **29**, Inoue teaches user recording equipment that reduces cut-offs when programs are recorded (See Fig. 1 and Col. 1 lines 60-67 Col. 2 lines 1-60), the user recording equipment comprising: control circuitry that is configured to: receive a user selection of a program to record; and predict a time change associated with the program, (See Fig. 2 Input and output information controller CPU 23a and Col. 1 lines 60-67 Col. 2 lines 1-60) wherein the predicted time change information is based on time changes for previous programs related to the program (Col. 8 lines 32-67); and a media

recording device that is responsive to the control circuitry and that is configured to record the program to compensate for a time change based on the predicted time change (See Fig. 1 Second Memory Unit 26 and Col. 1 lines 60-67 Col. 2 lines 1-60).

Regarding claims **30, 33-35, 38-45, 52-54**, claims **30, 33-35, 38-45, 52-54** are functions performed by the apparatus of claim 29 related to method claims 2, 5-7, 10-17, 24-26, respectively. Therefore, claims **30, 33-35, 38-45, 52-54** are analyzed and rejected according to claims 2, 5-7, 10-17, 24-26.

Regarding claim **57**, Inoue teaches allowing the user to change the predicted time change information (See Col. 7 lines 32-48 In Inoue, as interpreted in Response to Arguments above, service additional information is predicted time change. The user can change which service additional information used to construct the EPG. Thus, the user can change predicted time change information).

Regarding claim **58**, claim **58** is an apparatus claim 29 related to method claim 57. Therefore, claims **58** is analyzed and rejected according to method claim 57.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2623

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **27-28** and **55-56** are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al.

Regarding claim **27**, Inoue teaches wherein trimming the recording comprises trimming based on a confidence level in user's preferred programming for the scheduled program and the adjacent program (See Fig. 15 Step 42 Col. 17 lines 36-67, Col. 18 1-6 and Col. 19 lines 8-20). Establishing a confidence level based on user preferred programming is different than establishing a confidence level based on time change information. However, both methods of establishing a confidence level are similar in that both methods rely on previously logged data. Inoue also teaches various types of information including information about program distribution time can be used to decide which program is trimmed (See Col. 1 lines 22-30, Col. 9 lines 1-36, and Col. 11 lines 20-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Inoue's method of determining which program is trimmed based on a confidence level in time change information for the scheduled and the adjacent program in order to provide Inoue's method an alternate way of automatically choosing which program to trim (See Col. 2 lines 16-25).

Regarding claim **28**, Inoue teaches wherein trimming comprises trimming a time changed recording time of the scheduled program when time change information for the scheduled program has a lower confidence level than the adjacent program (See Col. 9 lines 1-22 Either program can be trimmed).

Regarding claims **55-56**, claims 55-56 are functions performed by the apparatus of claim 29 related to method claims 27-28, respectively. Therefore, claims **55-56** are analyzed and rejected according to claims 27-28.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/821,005
Art Unit: 2623

Page 10

JS

A handwritten signature in black ink, appearing to read 'Chris Grant', is positioned above the printed name.

**CHRISTOPHER GRANT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600**